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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,940	01/10/2001	R. Mark Halligan	77901	8523

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EXAMINER	
MOONEYHAM, JANICE A	
ART UNIT	**PAPER NUMBER**
3629	

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/757,940	HALLIGAN ET AL.	
	Examiner	Art Unit	
	Janice A. Mooneyham	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 February 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *96-101,103-110 and 112-118* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *96-101, 103-110 and 112-118* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

1. This is in response to the communication filed on February 20, 2005, wherein:

Claim 96-101, 103-110 and 112-118 are currently pending in this application;

Claims 96-101, 103-110 and 112-118 have been amended;

Claims 102 and 111 have been canceled but have been incorrectly labeled as being withdrawn. The status identifier should indicate that the claims 102 and 113 are canceled under the Revised Amendment Practice as set forth in 37 CFR 1.121 (effective data July 30, 2003). It is requested that applicant make the appropriate correction in any subsequent responses.

Response to Amendment

Specification

2. The objection as to the abstract is hereby withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 96-101, 103-110 and 112-118 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The applicant has identified an invention which requires the user to input information into a computer through the use of a questionnaire with multiple-choice questions wherein many of the questions have answers which only provide answers that can only be provided by the subjective analysis of the user. Because the answers are subjective, for a single situation, there could be different results based on the subjective analysis and determination of each user. Thus, the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to use the invention since the subjective interpretation does not provide a concrete result which can be used by one in the industry other than the person actually entering the information.

Furthermore, claims 96-101, 103-110 and 112-118 are also rejected under 35 U.S.C. 112, first paragraph since the claimed invention is not supported by either a specific asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention. It is unclear how one skilled in the art would know what the numerical score derived by the invention would be used or what the meaning of the score is to anyone other than the person actually entering the information. It is unclear how the numerical score value would be used by a person in the industry, i.e., what does the score mean to a person in the industry, especially in view of the fact that any comparison is made by comparing the assigned values with a predetermined threshold value which is not an industry standard value or a mathematically derived standard but rather a value chosen by the user (page 15 of the remarks section to the response).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 96-101, 103-110 and 112-118 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant states in the preamble that the invention is directed to the analysis, auditing, accounting, protection, and other management relating to an existence, ownership, access and employee notice of a plurality of trade secrets of an organization. The Examiner is unclear where the auditing and accounting steps are set forth in the body of the claims.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 96-101, 103-110 and 112-118 are rejected under 35 U.S.C. 101 because for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. "Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect

In the present case, many of the answers to the multiple-choice questions in the questionnaire are subjective. Thus, because the answers are subjective, for a single situation, there could be different results based on the subjective determination of the user. Therefore, the applicant's invention is not capable of providing concrete results as required by 35 U.S.C. 101 since it would be difficult for a person to repeat the analysis and determination of another based on the subjective subject matter.

Furthermore, the claimed invention is not supported by either a credible asserted utility or a well established utility. It is unclear how the specific utility of the claimed invention as described in the disclosure of this application would be useful or tangible to one in the industry. It is unclear how the numerical score value would be used by a person in the industry, i.e., what does the score mean to a person in the industry, especially in view of the fact that any comparison is made by comparing the assigned values with a predetermined threshold value which is not an industry standard value or a mathematically derived standard but rather a value chosen by the user (page 15 of the remarks section to the response). For example, an academic test score of 95 is considered an A unless specifically defined otherwise. What does the numerical score value that is derived by this invention mean and to whom does it have a meaning. Is there a threshold value that has a real world meaning?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 96, 103-105, 112-114 and 118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spencer (US 6,356,909) (hereinafter referred to as Spencer) in view of Barney et al (6,556,992) (hereinafter referred to as Barney).

Regarding Claims 96, 105 and 114:

Spencer discloses computer method, system and program, comprising:

providing a questionnaire of multiple-choice questions (Figures 14, col. 12, line 65 thru col. 13, line 18 - *multiple choice questions*) ;

providing a numerical score value to each of the responses on the questionnaire (col. 12, line 65 thru col. 13, line 18 *multiple choice questions may have a sliding value depending on the answer selected. Each question/selection is given a weight that is used to develop a scorecard*);

accepting responses to the questionnaire through the input device (col. 13, lines 11-18 *individual question responses*, Figure 3A – (4) *Response database*);

converting the responses received to a numerical score value (col. 12, line 65 thru col. 13, line 18 *scorecard*).

Spencer does not disclose that the subject matter of the invention is trade secrets or that the questions relate to the six factors for a trade secret of the First

Restatement of Torts, or calculating a geometric mean, the sixth root of the product, of the numerical score values to create a single metric, or repeating the program for each of the remaining items to be evaluated or ranking the items in ascending or descending order of the calculated metric.

However, Barney discloses repeating the program for each of the remaining items to be evaluated and ranking the items, wherein the items are patents and other intangible intellectual property assets (*trade secrets*) (col. 5, lines 56-62, col. 6, lines 3-9 *ratings or rankings are generated using a database of information by identifying and comparing various characteristics of each patent to a statistically determined distribution of the same characteristic within a given patent population*, col. 7, lines 51-60 – *ranking in ascending or descending order is inherent in the definition of ranking as admitted by applicant on page 18 or the Remarks*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the ranking of intellectual property assets as taught by Barney into the disclosure of Spencer so as to allow an entity to identify and study relevant characteristics of intellectual property to determine and measure those metrics that are predictive of a possible future event, such as an intangible intellectual property asset being litigated.

Although Barney discloses a rating for patents and other intangible intellectual property assets, neither Spencer or Barney explicitly disclose rating trade secrets or the questions relating to the six factors for a trade secret of the First Restatement of Torts

or calculating a geometric mean, the sixth root of the product, of the numerical score value.

However, a geometric mean is old and well known. Geometric mean as defined by the Merriam Webster on line dictionary as:

> Main Entry: **geometric mean**
> Function: *noun*
> : the nth root of the product of *n* numbers; *specifically* : a number that is the second term of three consecutive terms of a geometric progression <the *geometric mean* of 9 and 4 is 6>

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Spencer to include a geometric mean that is the sixth root of the product since the applicant has identified six factors for a trade secret, thus the 6^{th} root of the product of 6 numbers to come up with a numerical score value which can be used for comparison purposes when making an analysis of the trade secret.

The fact that the subject matter is about trade secrets or that the questions relate to the First Restatement of Torts is determined to be non-functional descriptive data. The language is not functionally interrelated with the useful acts, structure or properties of the claimed invention. The weighted scoring and ranking would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack,* 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983), *In re Lowry,* 32 F. 3d. 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide weighted scoring and ranking of trade secrets because such data does not functionally relate to the steps of the method or the structure of the system and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Regarding Claims 103 and 112:

Barney discloses assigning the value further comprises assigning numeric values on a scale of one to five or a scale of zero to ten (col. 9, lines 28-37,col. 24, lines 36-49 *ratings are provided on a scale from 1-10*).

Regarding Claims 104, 113 and 118:

Barney discloses wherein generating one or more metrics further comprises comparing the assigned values with predetermined threshold values (col. 6, lines 3-23 *comparing various characteristics of each patent to a statistically determined distribution (threshold) of the same characteristic*).

7. Claims 97-101, 106-110, 115-117 rejected under 35 U.S.C. 103(a) as being unpatentable over Spencer and Barney as applied to claims 96, 105 and 114 above, and further in view of Haber et al (US 5,136,646) (hereinafter referred to as Haber)

Regarding Claims 97,106 and 115:

Haber discloses creating an application fingerprint of the data (col. 3, lines 50-55).

Regarding Claims 98 and 107:

Haber discloses creating the application fingerprint comprises processing the content using a deterministic one-way algorithm (col. 3, lines 29-49).

Regarding Claims 99, 108 and 116:

Haber discloses transferring the fingerprint from a creator to a trusted third party (col. 2, lines 32-40 (outside agency), col. 3, lines 6-9 (*outside time-stamping agency (TSA)*).

Regarding Claims 100, 109 and 117:

Haber discloses creating a certificate fingerprint from the application fingerprint by the trusted third party (Col. 4, lines 22-40).

Regarding Claims 101 and 110:

Haber discloses transmitting the certificate fingerprint from the trusted third party to the creator of the application fingerprint as a certificate (abstract – *the certified receipt bearing the time data and the catenate certificate number is then returned to the author as evidence of the document's existence*, col. 4, lines 22-40).

Response to Arguments

8. Applicant's arguments with respect to claims 96-101, 103-110 and 112-118 have been considered but are moot in view of the new ground(s) of rejection.

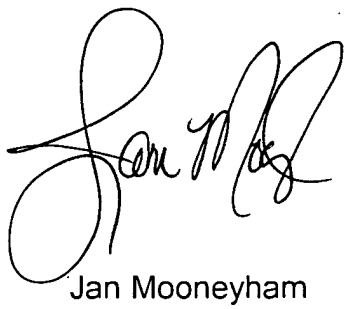
The applicant has extensively amended the claim language to overcome the rejections in the Office Action dated October 6, 2004. For example, the applicant has identified the values and how they are assigned. The applicant has identified a questionnaire with multiple choice questions which incorporate the six factors of the First Restatement of Torts, thus identifying the generally accepted legal criteria, a geometric mean of the numerical score, this being the sixth root of the product and has incorporated language to overcome the technological arts rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM



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